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changing a volume of the alert sound only for said call when the alert sound is being generated and a predetermined operation is specified by the user, without affecting the volume of the alert sound for subsequent future calls, while leaving a [communication] call ringing status [between] , as perceived by the remote caller, of the call from the remote caller [and] to the communication apparatus unchanged.--

REMARKS

Claims 1-19 remain in the application with claims 1 and 13 having been amended.

Reconsideration is respectfully requested of the rejection under 35 U.S.C. §103(a) of claims 1-5, 11-15, 18 and 19 as being unpatentable over United States Patent No. 5,657,372 to Ahlberg et al. in view of United States Patent No. 5,233,641 to Maeda.

The Examiner stated that the invention recited in the claims is substantially disclosed by Ahlberg et al. The Examiner admitted, however, that Ahlberg et al. does not disclose control means that controls the alert sound generator to change a volume of the alert sound only for the receive call while a communication state between the terminal and the remote caller remains unchanged. The Examiner alleged that

Maeda discloses control means that controls the alert sound generator to stop only for the received call while a communication state between the terminal and the remote caller remains unchanged. The Examiner alleged that it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Ahlberg et al. using the purported teachings of Maeda in a manner suggested by the Examiner.

It is submitted that the cited prior art does not disclose or suggest control of the alert sound in the manner provided in the present invention as recited in four-times amended claims 1 and 13.

Ahlberg et al. relates to a cellular radio communications system which permits a user of a cellular telephone to accept a telephone call from another telephone while delaying the establishment of voice communications with the other telephone until the user provides a predetermined signal.

Ahlberg et al., as the Examiner admitted, does not disclose that when the alert sound generator is generating the alert sound and the means for specifying the predetermined operation is operated by the user, the control means controls the alert sound generator to change a volume of the alert sound only for the received call, without affecting the volume

of the alert sound for future received calls, while a call ringing state, as perceived by the remote caller, of the call to the terminal from the remote caller remains unchanged, as set forth in four-times amended claim 1.

Further, while Ahlberg et al. describes that, in response to an alert sound indicating an arrived call, the user of cellular telephone 21 can accept the telephone call without establishing voice communications with the caller by activating the hold selection means 50 as a result of which the alert sound terminates, acceptance of the call is also expressly indicated to the caller, such that the caller becomes aware that he/she is being placed on hold by the user, an undesirable effect that the present invention, as recited in four-times amended claims 1 and 13, avoids. Specifically, Ahlberg et al. fails to disclose changing a volume of the alert sound only for the call when the alert sound is being generated and a predetermined operation is specified by the user, without affecting the volume of the alert sound for subsequent future calls, while leaving a call ringing status, as perceived by the remote caller, of the call from the remote caller to the communication apparatus unchanged, as set forth in four-times amended claim 13.

Maeda fails to cure the deficiencies of Ahlberg et al.

Maeda relates to radio telephone equipment having a sounding device, a drive circuit for driving the sounding device, and a control circuit for controlling the drive circuit. When a user operates the equipment to originate a call to another party, the equipment interchanges various control signals with a base station to set up a channel for communication. When the other party responds, the base station sends to the equipment a control signal indicating that the other party has responded to the call. In response, the control circuit of the equipment activates the sounding device drive circuit which in turn generates a predetermined alert tone to indicate to the user that the user can commence a conversation with the other party.

Maeda describes circumstances materially different from the present invention. ¹Indeed, Maeda does not even relate to controlling an alert sound informing a user of a received call from a remote caller, which is the subject matter of the present invention as recited in the claims. Since Maeda describes in, *inter alia*, the portion cited and relied upon by the Examiner, that the user of the equipment initiates the call, the volume of the alert sound indicating a connection of the call to the other party is presumably not a concern to the user. Therefore, it is unlikely that one of ordinary skill would have looked to the teachings of Maeda at

all in connection with the subject matter of the present invention.

Moreover, Maeda, like Ahlberg et al., fails to disclose (1) that when the alert sound generator is generating the alert sound and the means for specifying the predetermined operation is operated by the user, the control means controls the alert sound generator to change a volume of the alert sound only for the received call, without affecting the volume of the alert sound for future received calls, while a call ringing state, as perceived by the remote caller, of the call to the terminal from the remote caller remains unchanged, as set forth in four-times amended claim 1, and (2) changing a volume of the alert sound only for the call when the alert sound is being generated and a predetermined operation is specified by the user, without affecting the volume of the alert sound for subsequent future calls, while leaving a call ringing status, as perceived by the remote caller, of the call from the remote caller to the communication apparatus unchanged, as set forth in four-times amended claim 13.

Therefore, even if it would have been obvious for one of ordinary skill in the art at the time of the invention to combine the teachings of Ahlberg et al. and Maeda in the manner suggested by the Examiner, the combination would nevertheless fail to disclose the claimed invention because

neither Ahlberg et al. nor Maeda discloses or suggests (1) that when the alert sound generator is generating the alert sound and the means for specifying the predetermined operation is operated by the user, the control means controls the alert sound generator to change a volume of the alert sound only for the received call, without affecting the volume of the alert sound for future received calls, while a call ringing state, as perceived by the remote caller, of the call to the terminal from the remote caller remains unchanged, as set forth in four-times amended claim 1, and (2) changing a volume of the alert sound only for the call when the alert sound is being generated and a predetermined operation is specified by the user, without affecting the volume of the alert sound for subsequent future calls, while leaving a call ringing status, as perceived by the remote caller, of the call from the remote caller to the communication apparatus unchanged, as set forth in four-times amended claim 13.

Further, it is respectfully submitted that it would not have been obvious for one of ordinary skill in the art at the time of the invention to combine the teachings of Ahlberg et al. and Maeda in the manner suggested by the Examiner.

The Examiner is reminded that the mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the

prior art itself suggested the desirability of the modification. In re Fritch, 972 F.2d 1260, 1266 (Fed Cir. 1992). The motivation to combine cannot come from the present invention. Heidelberger Druckmaschinen AG v. Hantscho Commercial Products, Inc., 21 F.3d 1068, 1072 (Fed. Cir. 1994).

There is neither a teaching nor a suggestion in Ahlberg et al. or Maeda to make the modifications suggested by the Examiner. Moreover, as pointed out hereinabove, since Maeda describes circumstances in which the volume of the alert sound is not a concern to the user, it is unlikely that one of ordinary skill would have looked to the teachings of Maeda at all in connection with the subject matter of the present invention, much less to modify the teachings of Ahlberg et al.

Should the Examiner disagree therewith, it is respectfully requested that the Examiner specify where in the cited document there is a basis for such disagreement.

The Examiner admitted that the combination of Ahlberg et al. and Maeda fails to disclose that the control means controls the state of the alert sound generator to reduce the volume of the alert sound. The Examiner stated, however, that control means for controlling the state of an alert sound generator to reduce the volume of the alert sound are well known in the art such as in telephones where there

are ringer controls to control the ringer volume if it's too loud or too low. The Examiner alleged that it would have been obvious to one of ordinary skill in the art at the time the invention was made modify the combination of Ahlberg et al. and Maeda to include conventional ringer controls in a manner suggested by the Examiner.

Even if it would have been obvious for one of ordinary skill in the art at the time of the invention to modify the combination system of Ahlberg et al. and Maeda to include conventional ringer controls in the manner suggested by the Examiner, the modified system would nevertheless fail to disclose the claimed invention because neither Ahlberg et al. nor Maeda nor the conventional alert sound controller discloses or suggests (1) that when the alert sound generator is generating the alert sound and the means for specifying the predetermined operation is operated by the user, the control means controls the alert sound generator to change a volume of the alert sound only for the received call, without affecting the volume of the alert sound for future received calls, while a call ringing state, as perceived by the remote caller, of the call to the terminal from the remote caller remains unchanged, as set forth in four-times amended claim 1, and (2) changing a volume of the alert sound only for the call when the alert sound is being generated and a predetermined

operation is specified by the user, without affecting the volume of the alert sound for subsequent future calls, while leaving a call ringing status, as perceived by the remote caller, of the call from the remote caller to the communication apparatus unchanged, as set forth in four-times amended claim 13.

Claims 2-5, 11 and 12 depend either directly or indirectly from claim 1 which for the reasons set forth hereinabove is thought to be patentably distinct over the cited prior art and for at least those very same reasons, claims 2-5, 11 and 12 are also submitted to be patentably distinct thereover.

Claims 14, 15, 18 and 19 depend either directly or indirectly from claim 13 which for the reasons set forth hereinabove is thought to be patentably distinct over the cited prior art and for at least those very same reasons, claims 14, 15, 18 and 19 are also submitted to be patentably distinct thereover.

Reconsideration is respectfully requested of the rejection under 35 U.S.C. §103(a) of claim 16 as being unpatentable over Ahlberg et al. in view of Maeda and further in view of United States Patent No. 5,276,729 to Higuchi et al.

The Examiner admitted that the combination of

Ahlberg et al. and Maeda fails to disclose that the predetermined period of time during which the key is depressed is substantially equal to one second. The Examiner stated, however, that Higuchi et al. discloses that a user may answer a call by pressing a send key for a predetermined period of time substantially equal to one second in order to answer an incoming call and discontinue the ringing of the telephone. The Examiner alleged that it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the combination of Ahlberg et al. and Maeda using the teachings of Higuchi et al. in a manner suggested by the Examiner.

As pointed out hereinabove, the cited prior art including Ahlberg et al. and Maeda fails to disclose changing a volume of the alert sound only for the call when the alert sound is being generated and a predetermined operation is specified by the user, without affecting the volume of the alert sound for subsequent future calls, while leaving a call ringing status, as perceived by the remote caller, of the call from the remote caller to the communication apparatus unchanged, as set forth in four-times amended claim 13 from which claim 16 depends indirectly.

Higuchi et al. fails to cure the deficiencies of the other cited prior art including Ahlberg et al. and Maeda.

Higuchi et al. relates to a remotely programmable radiotelephone which is controllable using dual-tone, multiple-frequency tones.

While Higuchi et al. describes that the radiotelephone has conventional keypad buttons which may be used by the user for controlling the volume level of the ringer and the ringer tone until the volume level is adjusted again by operating the buttons, Higuchi et al., like the other cited prior art including Ahlberg et al. and Maeda, fails to disclose changing a volume of the alert sound only for the call when the alert sound is being generated and a predetermined operation is specified by the user, without affecting the volume of the alert sound for subsequent future calls, while leaving a call ringing status, as perceived by the remote caller, of the call from the remote caller to the communication apparatus unchanged, as set forth in four-times amended claim 13 from which claim 16 depends indirectly.

Therefore, even if it would have been obvious for one of ordinary skill in the art at the time of the invention to modify the combination system of Ahlberg et al. and Maeda using the teachings of Higuchi et al. in the manner suggested by the Examiner, the modified system would nevertheless fail to disclose the claimed invention because neither Higuchi et al. nor the other cited prior art including Ahlberg et al.

and Maeda discloses or suggests changing a volume of the alert sound only for the call when the alert sound is being generated and a predetermined operation is specified by the user, without affecting the volume of the alert sound for subsequent future calls, while leaving a call ringing status, as perceived by the remote caller, of the call from the remote caller to the communication apparatus unchanged, as set forth in four-times amended claim 13 from which claim 16 depends indirectly.

Reconsideration is respectfully requested of the rejection under 35 U.S.C. §103(a) of claims 6-10 and 17 as being unpatentable over Ahlberg et al. in view of Maeda and further in view of United States Patent No. 5,491,745 to Roeder and United States Patent No. 5,406,618 to Knuth et al.

The Examiner admitted that the combination of Ahlberg et al. and Maeda fails to disclose a power source, wherein the control means breaks off power when the power key is depressed for at least a predetermined period of time and the control means changes the state of the alert generator when the power key is depressed for a period of time shorter than the predetermined period of time. The Examiner stated that telephones comprising a control means, multifunction keys and a power source, such as a power key used to power on/off a telephone by pressing a key for substantially equal to one

second which eliminates a ringing signal of an incoming call are well known in the art. The Examiner also stated that Roeder discloses a dual mode keypad permitting one-touch dialing in which a key is depressed for a time shorter than the predetermined period of time. The Examiner further stated that Knuth et al. teaches a one-touch control telephone answering device that can perform multiple functions all by activating a single button to change the state of the alert generator. The Examiner alleged that it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the combination of Ahlberg et al. and Maeda with the teachings of Roeder and Knuth et al.

As pointed out hereinabove, the cited prior art including Ahlberg et al. and Maeda fails to disclose (1) that when the alert sound generator is generating the alert sound and the means for specifying the predetermined operation is operated by the user, the control means controls the alert sound generator to change a volume of the alert sound only for the received call, without affecting the volume of the alert sound for future received calls, while a call ringing state, as perceived by the remote caller, of the call to the terminal from the remote caller remains unchanged, as set forth in four-times amended claim 1 from which claims 6-10 depend indirectly, and (2) changing a volume of the alert sound only

for the call when the alert sound is being generated and a predetermined operation is specified by the user, without affecting the volume of the alert sound for subsequent future calls, while leaving a call ringing status, as perceived by the remote caller, of the call from the remote caller to the communication apparatus unchanged, as set forth in four-times amended claim 13 from which claim 17 depends directly.

Roeder and Knuth et al. fail to cure the deficiencies of the other cited prior art including Ahlberg et al. and Maeda.

Roeder relates to a telephone apparatus which retrieves and dials previously stored telephone or billing account numbers by pressing one of the keys of a standard 12-key keypad.

Knuth et al. relates to a telephone answering device that is activated by a proximity sensor when a user crosses its field of detection and whose operation is controlled by simple voice commands.

While Roeder describes a dual mode keypad permitting one touch dialing and while Knuth et al. describes one touch dialing, Roeder and Knuth et al., like the other cited prior art including Ahlberg et al. and Maeda, fail to disclose (1) that when the alert sound generator is generating the alert sound and the means for specifying the predetermined operation

is operated by the user, the control means controls the alert sound generator to change a volume of the alert sound only for the received call, without affecting the volume of the alert sound for future received calls, while a call ringing state, as perceived by the remote caller, of the call to the terminal from the remote caller remains unchanged, as set forth in four-times amended claim 1 from which claims 6-10 depend indirectly, and (2) changing a volume of the alert sound only for the call when the alert sound is being generated and a predetermined operation is specified by the user, without affecting the volume of the alert sound for subsequent future calls, while leaving a call ringing status, as perceived by the remote caller, of the call from the remote caller to the communication apparatus unchanged, as set forth in four-times amended claim 13 from which claim 17 depends directly.

Therefore, even if it would have been obvious for one of ordinary skill in the art at the time of the invention to modify the combined system of Ahlberg et al. and Maeda using the teachings of Roeder and Knuth et al. in the manner suggested by the Examiner, the modified system would nevertheless fail to disclose the claimed invention because neither Roeder nor Knuth et al. nor the other cited prior art including Ahlberg et al. and Maeda discloses or suggests (1) that when the alert sound generator is generating the alert

sound and the means for specifying the predetermined operation is operated by the user, the control means controls the alert sound generator to change a volume of the alert sound only for the received call, without affecting the volume of the alert sound for future received calls, while a call ringing state, as perceived by the remote caller, of the call to the terminal from the remote caller remains unchanged, as set forth in four-times amended claim 1 from which claims 6-10 depend indirectly, and (2) changing a volume of the alert sound only for the call when the alert sound is being generated and a predetermined operation is specified by the user, without affecting the volume of the alert sound for subsequent future calls, while leaving a call ringing status, as perceived by the remote caller, of the call from the remote caller to the communication apparatus unchanged, as set forth in four-times amended claim 13 from which claim 17 depends directly.

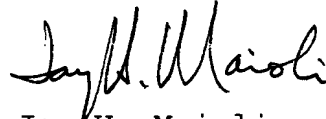
Accordingly, it is respectfully submitted that there is no showing or suggestion in the prior art of record of a communication terminal for informing a user of a received call from a remote caller by an alert sound wherein when the alert sound generator is generating the alert sound and the means for specifying the predetermined operation is operated by the user, the control means controls the alert sound generator to change a volume of the alert sound only for the received call,

without affecting the volume of the alert sound for future received calls, while a call ringing state, as perceived by the remote caller, of the call to the terminal from the remote caller remains unchanged, in any of the proper references for consideration alone or in combination absent the teaching of the present invention as set forth in the claims.

Favorable reconsideration is earnestly solicited.

Respectfully submitted,

COOPER & DUNHAM LLP

A handwritten signature in cursive script, appearing to read "Jay H. Maioli".

Jay H. Maioli

Reg. No. 27,213

JHM/PT/ds